

### **REMARKS**

In response to the outstanding Office Action, claim 59 is canceled and certain claims have been amended. Based on the reasons set forth next that all pending claims are patentably distinct over the art and are maintained to be in condition for allowance. It is respectfully requested that the Examiner reconsider the rejection in light of the amendments and the reasons that follow.

The Office Action recognizes the entry of the Second Preliminary Amendment filed 2/12/2004. A First Preliminary Amendment was also filed 11/13/2003 and was properly entered.

### **CLAIM REJECTIONS – 35 U.S.C. § 112**

Claim 60 has been amended to delete “the bonus game” and to provide proper antecedent basis by adding “play in the gaming machine” which is stated in claim 60.

Claim 61, although not rejected, has also been amended to provide proper antecedent basis as above for claim 60.

It is respectfully maintained that these amendments to claims 60 and 61 point out and distinctly claim the subject matter under 35 U.S.C. § 112 and that they be allowed.

### **CLAIM REJECTIONS – 35 USC 102**

Claims 54-64, 66-67, and 69-72 are rejected under 35 U.S.C. § 102(e) as being anticipated by Frohm 6,234,897.

The Frohm '897 reference was filed on August 25, 1999 which is after the claimed priority date of March 2, 1999. Frohm '897 claims “continuation-in-part” priority to Frohm Serial No. 09/140,947 filed August 27, 1998 (now 6,203,429). The following addresses Frohm '429, but the reasoning also applies to both the '897 and '429 Frohm patents except where that portion of Frohm '897 is not found in Frohm '429.

Frohm '897 recognizes that in “the competitive gaming machine industry, there is a continuing need for gaming machine manufacturers to produce new types of games, or enhancements to existing games, which will attract frequent play by enhancing the entertainment value and excitement associated with the game” column 1, lines 34-39. For the reasons set forth next, it is respectfully maintained that Frohm '429 does not anticipate,

nor render obvious, these claims and that the claimed inventions therein represent novel and nonobvious casino games or enhancements thereto that meet this recognized industry wide continuing need.

With respect to the rejection of claims 54 and 55, Frohm '429 does disclose using a plurality of symbols (Figure 2) which is randomly displayed 108 (Figure 4) as is old and well known in the art. Frohm '429 sets forth standard symbols such as bars, cherries, red and blue 7s, etc. throughout his figures and specification (see Figure 3, for example). Frohm '429 does not disclose (as required under 35 U.S.C. § 102) at least including any symbol that is either a "value" symbol or an "end of game" symbol as disclosed, defined and claimed.

Claims 54 and 55 are patentably distinct over Frohm '429 based on the following five reasons:

**1. Frohm '429 has no disclosure of "at least including value symbols" in the claimed plurality of symbols that are randomly displayed in claims 54 and 63:**

Independent claim 54 recites at least including value symbols in the claimed plurality of symbols. Each value symbol of the claimed invention corresponds to winning credit(s) as fully illustrated and set forth in the specification. Frohm '429 discloses the conventional "Blue 7" symbol, but the number "7" in the "Blue 7" has no "value" meaning as claimed herein. The rejection equates "value symbols" with "winning symbols", but Frohm requires a "combination" of winning symbols to award his player, nothing in Frohm discloses any individual symbol being an award value such as credits. If three "Blue 7" symbols are obtained on the Frohm pay line, then "500" credits are paid or if one "Blue 7" is obtained, then 100 credits are paid (see Figure 3) as determined in the fixed pay table in the design of the game. In the claimed invention, the "value symbol" corresponds to an award value of credits so when the number "4" aligns on the pay line in the claimed invention, it has an award value of 4 credits. While believed to be implicit in the specification's definition and use of the word "value", claim 54 has been amended to add the word "award" before value to clarify this meaning. No new search is required as the word "award" was used in claim 69. Claim 54 is not anticipated, nor rendered obvious, by Frohm '429.

**2. Frohm '429 has no disclosure of "determining the values in any value symbols displayed" in the random display as claimed in claims 54 and 63:** Frohm '429 only pays credits for "winning combinations" of symbols based on a pay table. In Figure 3,

the pay table credits for a winning combination of three "Blue 7s" is "500" credits. The Rejection cites column 3, lines 64-66 and column 7, lines 40-42 of Frohm '897 (column 5, lines 4-7, column 9, lines 43-45 of Frohm '429). But, these cites emphasize "winning combination," Frohm has no disclosure, here or elsewhere, of determining the "values", let alone of "any values" of any individual symbol randomly displayed. With the above amendment to "award values", it further clarifies why the step of determination occurs. Frohm '429 is only concerned whether a winning or losing "combination of symbols" is randomly displayed. Frohm has no disclosure of determining the value in any symbol displayed in the combination. Claim 54 is further amended to add "in the combination" to clarify. No new search is required as this has antecedent basis in step a. Claim 54 is not anticipated, nor rendered obvious, by Frohm '429.

**3. Frohm '429 has no disclosure of accumulating "the determined values to an accumulated winnings value:"** The Office Action cites Figures 7 and 8, column 7, lines 40-62 of Frohm '897 (Figures 4 and 5 of Frohm '429, column 9, line 43 – column 10, line 10). In Frohm '429, the player may have a winning combination in the base game (step 108 in Figure 4). If, the player has three Win Streak symbols displayed any where in the payout window in step 110, then the player plays the bonus game with the result displayed in step 134 of Figure 5. When the player wins in the bonus game spin, the winnings are accumulated (added) to the base game winnings in step 140. This does not disclose the claimed invention of accumulating the determined values in the randomly displayed combination. Frohm '429 accumulates the winnings from at least two separate random displays (first the base game and then the bonus game(s)). The claimed invention accumulates (e.g., adds) the determined values together as displayed in the single random display and, then repeats this step of accumulation for each new random display in step d of claim 54). With the present amendments, Frohm '429 has no disclosure under 35 U.S.C. § 102 of ever accumulating "award values" as randomly displayed "in the combination" of symbols. Claim 54 is not anticipated, nor rendered obvious, by Frohm '429.

**4. Frohm '429 does not disclose the use of an end game symbol that is randomly displayed:** The Office Action cites Frohm '897 (see above for Reason #3). Frohm '429 in step 138 of Figure 5 determines when the random display of step 134 does not result in a win (payout). Thus, not having a winning combination of symbols in step 134

causes the game to pay the accumulated winnings (step 114) and then to end the game (step 116). Frohm '429 does not disclose using a predetermined number of end game symbols to end the game as claimed. Figure 3 of Frohm '429 shows the bonus game winning symbols, any other combination of symbols loses and results in no payouts which ends the bonus game. There is no special "end game" symbol that is used to end the game as claimed. Frohm uses any number of "losing symbol combinations of game symbols" to end bonus game play, not the presence of an end game symbol in "the combination." Frohm '429 does not disclose under anticipation, nor suggest or teach under obviousness, the use of the claimed "end game" symbol.

**5. Frohm '429 does not disclose repeating the three claimed steps" until a predetermined number of end game symbols is randomly displayed":** The Office Action cites Frohm '897 (see above for Reason 3). Frohm '429 understands the use of a "predetermined number " of symbols as when "three win streak" symbols are displayed on the pay line. When this occurs in step 110 of Figure 4, he uses, in step 122, a multiplier of two on any subsequent winnings in the bonus game. When a losing combination of symbols appears on the pay line in step 134 of Figure 5, then the Frohm bonus game ends. In the claimed invention games are continued to be played in "step d" until a predetermined number of end game symbols is reached. Frohm '429 does not disclose under anticipation, nor suggest or teach under obviousness, the use of a predetermined number of such end game symbols which when the predetermined number occurs ends the game. As claimed, this occurs in the repeat step of claim 54. Frohm is simple: the first loss ends further bonus game play. The present invention is simple as the first displayed end game symbol, does not end game play until a predetermined number of end game signals are accumulated in a repeat rounds. Claim 54 is amended to correct grammar to state "have been" randomly displayed. Frohm '429 does not disclose under anticipating, nor suggest or teach under obviousness, the use of a predetermined number of end game symbols.

In summary, claim 54, as amended, is not anticipated by Frohm '429 based on any one of the five reasons set forth above. Nor, does Frohm '429 render obvious claim 54 based on any one or combinations of these reasons.

Claim 55 claims the use of one end game symbol; no where in Frohm '429 is there any disclosure of ending a game simply based on the occurrence of one end game symbol in the

random display of the combination of symbols. Frohm '429 ends his game when any one of the numerous combination of different symbols loses. Claim 55 is patentably distinct as only one end game symbol (not limited to winning or losing symbol combinations on the pay line) occurs.

Claims 56-58 are patentably distinct for the reasons set forth above for claim 54.

Claim 56 recites a null signal which has a "zero credit value" (see, paragraph [0086]) and is used differently from the blank symbol of Table I paragraph [0052]. Claim 57 recites a value symbol that is a positive integer and claim 58 recites a value symbol that is a negative integer. The Rejection cites Figure 3 of Frohm '897 which appears to correspond to Figure 2 of Frohm '429. The numbers of "2", "3", "4" shown in Figure 2, are not symbol values, but the number of times, a game symbol "occurs" on a reel strip (see column 5, lines 49-65 of Frohm '429). Frohm '429 has no disclosure of any value symbol as defined and claimed. His symbols in Figure 2 are all game play symbols and in Figure 3 he shows the occurrence of such symbols. The Rejection concludes that negative integers is a preference, but there are no negative integers disclosed in Frohm '429 so an explanation of this conclusion, and support in Frohm '429, is respectfully requested. Claim 59 is canceled.

Claims 60-62 are patentably distinct for the reasons set forth above for claim 54.

With respect to claim 60, the rejection cites Figure 8, and column 7, lines 59-62 of Frohm '897, but this citation does not provide support to a "player stop signal" "received in response to the step of accumulating". Nor, is this language with respect to Figure 5 of Frohm '429. It is requested that this rejection be clarified and supported. Frohm '429 only ends his game when a losing symbol combination occurs. His player has no input control of ending the game. This claimed feature is not disclosed in Frohm '429 and for this reason alone this claim is patentably distinct.

With respect to claim 61, the rejection cites Figure 12 and column 9, lines 13-16 of Frohm '897 for disclosing ending the game when a predetermined amount of winnings occurs. There is no corresponding figure in Frohm '429 so this rejection is maintained to be moot. To be complete, however, even this citation in Frohm '897 does not disclose ending the game when "accumulated winnings" equals "a predetermined winnings value." Only a losing combination of symbols displayed on the pay line causes the game to end. This

claimed feature is not disclosed in Frohm '429 and for this reason alone this claim is patentably distinct.

With respect to claim 62, the reasons set forth for claim 55 are incorporated by reference. The Rejection cites column 7, lines 45-58 for support, but such support is not found and such support is respectfully requested to be stated. This citation has no disclosure of a "lose symbol" or an "end game symbol". Column 7, lines 45-58 only discuss the consolation leg starting with step 144 which occurs only when the number of spins equals 1. That is, the player is in the bonus game and receives a losing symbol combination on the first spin. Frohm '897 can provide a consolation prize rather than no award to make the player's trip to the bonus round rewarding rather than a disappointment. This leg appears to be found in Figure 5 of Frohm '429.

Independent claim 63 has many of the same inventive features found in independent claim 54. Claim 63 has also been amended to recite "award" values and displayed in the combination of. Reasons 1-4 for claim 54 are incorporated by reference herein. Claim 63, for these articulated reasons, is patentably distinct over Frohm '429.

Claim 63 further claims playing the game as a bonus game, ending the bonus game when a predetermined winnings value is reached, and provided an end game symbol has not been displayed. The rejection cites Figures 7 and 8 and column 7, lines 40-62 of Frohm '897 which corresponds to Figures 4 and 5 of Frohm '429. The reasons articulated in claim 61, above, are incorporated by reference. There is no disclosure in Frohm '429 of ending the bonus game when accumulated winnings equals a predetermined value provided an end of game symbol has not been displayed. Claim 63 is patentably distinct over Frohm '429.

With respect to claim 64, the Rejection cites Figure 8, column 7, lines 59-62 of Frohm '897 which corresponds to Figure 5 of Frohm '429. This citation, discloses that a first round bonus loss results in only the Total Pay award from the base game. That is, a first round bonus game loss has no accumulated bonus winnings, the bonus game ends, and the player only receives the base game winnings. This does not disclose awarding a different value in lieu of the accumulated bonus winnings when an end of game symbol occurs during play of the bonus game. Frohm '429, on a first spin play in his bonus game, accumulates nothing when the first spin loses. Claim 64 is patentably distinct over Frohm '429 for this reason alone.

With respect to claim 66, the reasons set forth for claim 63 is incorporated by reference and this claim is patentably distinct over Frohm '429. Frohm '429 has no disclosure of a predetermined value in relation to accumulated winnings. Frohm '429 does not have a figure corresponding to the citation of Figure 12 of Frohm '897. It is respectfully requested that support for this rejection in Frohm '429 be stated. To be responsive as the rejection is best understood, there is no separate end of bonus game play based on a predetermined limit of winnings in Frohm '897 or Frohm '429 as the player is awarded whatever is stated in the pay tables for the base game and for play of the bonus game. Bonus game play ends only when a losing combination of symbols occurs on the pay line as discussed above and incorporated herein by reference. Frohm '429 recognizes that the player spins until he loses (see column 8, lines 29-31) and, thus, Frohm teaches away from the claimed invention of limited winnings to a predetermined amount and then ending the game. Claim 66 is patentably distinct over Frohm '429 for this reason alone.

With respect to independent claim 67, Frohm '429 sets the count value to zero when the bonus game starts in step 112 of Figure 4 and each bonus game play increments the count in step 136 of Figure 5. But this is where the similarity ends. As set forth in Reason 4, above, and incorporated by reference herein, Frohm '429 does not disclose "at least one end game symbol". Frohm '429 only discloses ending the bonus game when a "losing combination of symbols" occurs on the pay line. Claim 67 further claims ending the bonus game when the count equals a predetermined value - that is bonus game play stops after a predetermined number of spins. The rejection cites Frohm '897 at Figures 7 and 8, column 7, lines 40-62 which appears to correspond to Figures 4 and 5 of Frohm '429. The citation only discusses the consolation prize, in the event the first spin results in a losing combination of symbols. Frohm '429 ends the bonus game only when a losing combination of symbols occurs on a spin, and the player keeps on playing spin after spin, regardless of the spin count in step 136 of Figure 5 of Frohm '429. Indeed, Frohm '429 teaches away as Frohm would have had a path from step 136 to the end game step 116 in Figure 5. Frohm '429 clearly states that the player "can play the bonus game on a spin-til-you-lose basis" Frohm '429, column 8, lines 29-31. The claimed invention ends the game when a predetermined count (number spins) is reached. Claim 67 is not anticipated, nor rendered obvious by Frohm '429.

Claim 67 is amended to recite "casino" before "bonus game" as in claim 69. This does not require a new search.

With respect to independent claim 69, there is no disclosure in Frohm '429 of "receiving a player stop signal." The cited column 3, lines 20-29 of Frohm '897 appears to be found at Frohm '429 column 4, lines 19-25. But, Frohm '429 discloses only that the player can be required to "start play" of a bonus game by inserting additional coins or credits. There is no disclosure of receiving "a player stop signal from a player input during play of the bonus game." Nor, is there any disclosure of "awarding at least the accumulated award values in response to receiving the player stop signal..." Frohm '429 only discloses that the player insert additional coins to start each bonus game play. Claim 69 further recites the use of an end of bonus game symbol and Reason 4 for claim 54 is incorporated herein by reference. The last two steps of claim 69 are not disclosed in Frohm '429. Claim 69 is not anticipated, nor rendered obvious by Frohm '429.

With respect to claims 70-72, the reasons set forth for claim 69 are incorporated by reference as well as the reasons set forth for claims 56-59. These claims are patentably distinct over Frohm '429.

#### **CLAIM REJECTIONS - 35 U.S.C. § 103**

Claims 65 and 68 are rejected under 35 U.S.C. § 103 based on Frohm '897 in view of Moody. Frohm '897 is not a reference for reasons stated. The following addresses Frohm '429 and the reasons set forth above for independent claims 63 and 67 are incorporated herein by reference.

Moody is further cited for paying a progressive game in response to ending the bonus game. Progressive games are old and well known in the art. However, when claims 65 and 68 are read with their corresponding independent claims as a whole, these two claims are non-obvious over Frohm '429 in view of Moody.

#### **CONCLUSION**

Claims 54-58 and 60-72 have been variously amended to clarify, correct grammar, and to provide proper antecedents. For the reasons set forth above these claims, as



amended, are patentably distinct over the prior art and the allowance of these claims is respectfully requested.

The additional art references has been reviewed and do not affect the patentability of these claims.

Should you have any questions regarding the above, please feel free to give the below-listed attorney a call. If additional fees are required, please debit our Deposit Account No. 04-1414.

Respectfully submitted,

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